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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,022

10/25/2006

Simona Grassi

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EXAMINER

O SULLIVAN, PETER G

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

09/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,022	Applicant(s) GRASSI ET AL.	
	Examiner Peter G. O'Sullivan	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/22/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

Claims 1-13 are pending in this application which should be reviewed for errors.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teaching of Lidor-Hadas et al, US 7,038,083, Gall et al., US 4,927,814, Blum et al., US 4,407,761, Blum et al., DE 2702631, and Kruger et al., DE 2658961, in view of Hancock et al, Journal of Pharmaceutical Sciences, Jan. 1997, Vol. 86, No. 1, pp. 1-12. Lidor-Hadas et al. disclose the production of, for example, risedronic acid or ibandronic acid, by reacting a carboxylic acid, phosphorous acid and a halophosphorous compound, for example phosphorus oxychloride in the presence of a diluent. Gall et al., adds to the above teaching by disclosing the alkali metal salts of their diphosphonic acids may be prepared by titration with, for example, aqueous sodium hydroxide (s. Col.

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6, top). For a similar reaction, Blum et al., '761, disclose diluents may be used, but particularly in the case when using phosphorous acid and POCl_3 , it is not necessary to use a diluent (s. Col. 3, top). Blum et al., '631, and Kruger et al., '961, add to the above teaching by disclosing similar reactions conducted without solvent.

The instant invention differs from the teaching of the primary references in that applicants' molar ratios of reactants are not taught and in that amorphous ibandronic acid sodium and its preparation by lyophilization or spray-drying is not taught. Han With regard to molar ratios, it is obvious to optimize the reaction and reaction conditions of an old process through routine experimentation to produce a new process. In re Aller et al., 105 USPQ 233. It would have been prima facie obvious at the time the invention was made to one of ordinary skill in the art to start with the teaching of the cited references, to make processes and to expect to produce their compounds.

No claim is allowed.

Any inquiry concerning this communication should be directed to Peter G. O'Sullivan at telephone number (571)272-0642.

/Peter G O'Sullivan/

Primary Examiner, Art Unit 1621